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3404 E. Harmony Road
Mail Stop 35
FORT COLLINS, CO 80528

EXAMINER

ALMEIDA, DEVIN E

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laura.m.clark@hp.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STUART CAIN

Appeal 2009-007224
Application 10/648,531¹
Technology Center 2400

Before LANCE LEONARD BARRY, CAROLYN D. THOMAS, and
DEBRA K. STEPHENS, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL²

¹ Application filed August 25, 2003. The real party in interest is Hewlett-Packard Development Company.

² The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final decision rejecting claims 1-20, which are all the claims pending in the application. We have jurisdiction over the appeal under 35 U.S.C. § 6(b).

We REVERSE.

The present invention relates to creating a security indication spanning tree. (Spec., 1, ll. 9-10.)

Claim 1 is illustrative:

1. A security indication spanning tree method comprising:
determining asset value of a network node;
ascertaining exposure rating of said network node;
establishing a functional priority risk indicator for
indicating the likelihood of an attack from another network node; and
creating a spanning tree schematic of a network including
said network node, wherein said spanning tree schematic includes an
indication of said asset value.

Appellant appeals the following rejections:

1. Claims 1-16, 19, and 20³ under 35 U.S.C. § 102(e) as anticipated by Fox (US 6,535,227 B1, Mar. 18, 2003); and
2. Claims 17 and 18 under 35 U.S.C. § 103(a) as unpatentable over Fox and Burrows (US Patent Pub. 2002/0073338 A1, June 13, 2002).

³ The Examiner withdrew the rejection of claims 4, 5, and 9 (Ans. 2). The Examiner's statement of the grounds of rejection inadvertently omits claims 8 and 11, however, the details that follow includes such claims (Ans. 3-6). Therefore, we shall treat this as a harmless error, given that Appellant understood that such claims were also rejected (App. Br. 7).

FACTUAL FINDINGS

Appellant's Specification

1a. Appellant's Specification discloses that "the asset value corresponds to the economic value of functions provided by a network component in the support of various applications." (Spec., 7, ll. 23-25.)

1b. Appellant's Specification further discloses that "[i]n one exemplary implementation the asset value corresponds to the economic impact of a disruption to the functionality provided by the network node." (Spec., 8, ll. 14-16.)

1c. Appellant's Specification discloses that "the relative importance of the device is based upon an economic value of functions the device performs in support of the applications." (Spec., 17, l. 25 to 18, l. 2.)

Fox

2a. Fox discloses "[a] graphical user interface . . . for determining the vulnerability posture of a network. . . . Selected portions of the network map turn a different color indicative of a vulnerability that has been established for that portion of the network after a vulnerability posture of the network has been established." (Abstract.)

2b. In Fox, "[t]he selected icons turn the color red indicative of a higher risk node, and selected icons turn yellow indicative of less severe risk node after a vulnerability posture of the network has been established." (Col. 3, ll. 55-59.)

ANALYSIS

Our representative claim, claim 1, recites, *inter alia*, “*determining asset value of a network node.*” Independent claim 10 recites a similar limitation. Independent claim 15 recites, *inter alia*, “*a relative importance of functionality provided by said device.*” As illustrated *infra*, each of these claimed limitations relates to an “economic value” of functions that the device performs. Thus, the scope of all independent claims 1, 10, and 15 include obtaining an economic value.

Issue: Did the Examiner err in finding that Fox discloses determining an asset value of a network node, as set forth in claim 1?

Appellant contends that “Fox’s ‘vulnerability’ is not the same as Appellant’s ‘asset value.’” (App. Br. 10.) Appellant further contends that “[t]he term ‘asset value’ should be read in light of the specification, which defines ‘asset value’ as the network node’s economic value or utility.” (*Id.*)

The Examiner found that “Claim 1 is broader than the applicant is arguing. The asset value can be any vulnerability or security and does not have to be an economic value of the network node to meet the limitations of the claims.” (Ans. 8.) We disagree with the Examiner.

In essence, Appellant argues that the term *asset value* identifies an “economic value,” whereas the Examiner found that the claimed *asset value* can be any “vulnerability” in the network. Thus, this case hinges on claim interpretation.

Regarding claim interpretation, during examination, claims are to be given their broadest reasonable interpretation consistent with the specification, and the language should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Amer. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004) (citations omitted). The Office must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. *Id.* (citations omitted). Here, Appellant's Specification expressly states that the "asset value" corresponds to the *economic value or impact* to the functionality provided by the network node (FF 1a-1b). Similarly, the Specification also indicates that "a relative importance" is based upon an economic value (FF 1c). Thus, consistent with Appellant's Specification, we find that the claimed "asset value" (Claims 1 and 10) (and claimed relative importance (Claim 15)) must necessarily include an *economic* indicator related to the functionality of the component.

The Examiner found that the "asset value" did not have to be an economic value (Ans. 8). We disagree with this finding given the expressed definitions noted *supra* in Appellant's Specification. A claim meaning is reasonable if one of ordinary skill in the art would understand the claim, read in light of the specification, to encompass the meaning. *See In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). Here, we find that one of ordinary skill in the art would understand the claims to encompass an economic value.

The Examiner has not shown, and we do not readily find, that Fox discloses an *economic value* being considered in Fox's method for assessing the security posture of a network. Instead, the Examiner merely directed our

attention to how Fox determines the vulnerability posture of a network (Ans. 7-8; and FF 2a-2b.) However, “vulnerability” merely looks at how open to attack a node is, not the economic impact an attack may have on the node.

"[A]nticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim" *In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) (citing *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984)). "[A]bsence from the reference of any claimed element negates anticipation." *Kloster Speedsteel AB v. Crucible, Inc.*, 793 F.2d 1565, 1571 (Fed. Cir. 1986). Here, the Examiner has not shown any economic value being considered in Fox. The Examiner further has not shown that Burrows makes up for the deficiencies of Fox.

Since we agree with at least one of the arguments advanced by Appellant, we need not reach the merits of Appellant's other arguments. It follows that Appellant has shown that the Examiner erred in finding that Fox renders the claims unpatentable.

In view of the above discussion, since Appellant has demonstrated that the Examiner erred in finding the argued limitations in the disclosure of Fox, the Examiner's 35 U.S.C. § 102(e) and 103(a) rejections of the claims is reversed.

DECISION

We reverse the Examiner's § 102 and § 103 rejections.

REVERSED

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Application 10/648,531

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Intellectual Property Administration
3404 E. Harmony Road
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